

Serial No. 10/821,595Docket No. 117-P-1345USD4

Remarks

Claims 1 and 20 have been amended to recite a two-part "curable" overcoat, claim 8 has been amended to recite that the intermediate coating has a "dry coating" thickness of about 2.5 to about 75 micrometers, and claims 11, 19 and 23 have been amended to recite a "thermally" curable overcoat. Support for these amendments may be found in the written description at, e.g., page 2, lines 9-10, page 6, line 23 and page 8, lines 16-27. Claim 22 has been editorially amended. Following entry of this amendment, claims 1-27, 36 and 37 will be pending in this application.

This Amendment is accompanied by a Communication enclosing fresh copies of the last three references listed on sheet 3 of the Substitute Form PTO-1449 submitted by applicants with their April 9, 2004 Information Disclosure Statement, together with a duplicate copy of sheet 3.

Rejection of Claims 1-27, 36 and 37 under 35 U.S.C. §102(b)

Claims 1-27, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by Published PCT Application No. WO 98/11168 (Hamrock et al.), on grounds *inter alia* that "All limitations of the claimed invention are either disclosed or inherent in the above reference". Applicants respectfully disagree. Hamrock et al. describe a vinyl floor coating system that may employ a primer coating (which solely for purposes of discussion could be referred to as an "intermediate coating") and a 100% solids **one-part** radiation curable composition (which solely for purposes of discussion could be referred to as an "overcoat"). The overcoat is made by combining a specially formulated polyfunctional isocyanurate monomer, a second monomer and a photoinitiator (see e.g., page 16, lines 26-28). The photoinitiator is chosen based in part on shelf life stability considerations (see e.g., page 14, line 17) and inhibitors may be added for prolonged storage (see e.g., page 17, lines 23-24). Hamrock et al.'s one-part radiation curable overcoat is not a "two-part curable overcoat" as recited in claims 1-27, 36 and 37. Those skilled in the art will appreciate that two-part curable compositions cure shortly after the two parts are mixed together, and that a one-part radiation

Serial No. 10/821,595Docket No. 117-P-1345USD4

curable composition does not ordinarily cure until the composition is exposed to light or other photocuring energy. Hamrock et al. do not disclose a "coated substrate comprising a strippable intermediate coating atop the substrate and a strip agent-permeable two-part curable overcoat adhered to the intermediate coating" as recited in rejected claims 1-27, 36 and 37. Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-27, 36 and 37 as being anticipated by Hamrock et al.

Rejection of claims 1-5, 7, 9-12, 15, 16, 18-24 and 27 under 35 U.S.C. §102(b)

Claims 1-5, 7, 9-12, 15, 16, 18-24 and 27 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,421,782 (Bolgiano et al.), on grounds *inter alia* that "Bolgiano et al. disclose flooring materials and a process for making such flooring materials whereby a substrate (**corresponding to the intermediate coating of the claimed invention**) is treated with a solution comprising water, acrylic acid and a surfactant (**corresponding to the topcoat of the claimed invention and meeting the limitations that the topcoat is UV curable and comprises an acrylate**)" (emphasis in original). Applicants respectfully disagree. Bolgiano et al. describe a factory process for coating vinyl flooring tiles. A radiation-curable first layer (which solely for purposes of discussion could be referred to as an "intermediate coating") is applied to the tiles followed by a second layer containing water, acrylic acid and a surfactant. Bolgiano et al.'s second layer is not a two-part curable overcoat, and moreover Bolgiano et al.'s second layer would be *more* strippable than Bolgiano et al.'s intermediate coating. Bolgiano et al.'s second layer contains no initiator. If coated by itself, it would not cure and would easily be stripped. Bolgiano et al.'s first layer is nonaqueous (see, e.g., col. 6, lines 11 and 53), is applied and cured using factory-type coating conditions in which the moving coated tiles are passed under medium pressure mercury lamps (see e.g., col. 5, lines 46-53), is not said to be strippable, and would be expected by a person skilled in the art to be very difficult to strip. Bolgiano et al. do not show and actually teach away from applicants' claimed coated substrate and strippable laminate finish kit. Applicants

Serial No. 10/821,595Docket No. 117-P-1345USD4

accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-5, 7, 9-12, 15, 16, 18-24 and 27 as being anticipated by Bolgiano et al.

Rejection of claim 21 under 35 U.S.C. §103(a)

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bolgiano et al. in view of Published PCT Application No. WO 94/22965 (Koreltz et al.), on grounds *inter alia* that:

"However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

"Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Bolgiano et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers."

As noted above, Bolgiano et al.'s composition is applied to tiles and cured using factory-type coating conditions in which the moving coated tiles are passed under medium pressure mercury lamps, is not said to be strippable, and would be expected by a person skilled in the art to be very difficult to strip. Koreltz et al.'s strippers are relatively mild, and would not be assumed by a person skilled in the art to be capable of removing Bolgiano et al.'s radiation-cured first layer. Even if Bolgiano et al. and Koreltz et al. were combined as proposed in the Office Action, the result would not make obvious a strippable laminate finish kit as recited in rejected claim 21, for at least the reason that Bolgiano et al. do not show a combination having a two-part curable overcoat that is "less strippable and more wear resistant than the dried intermediate coating". Applicants accordingly request withdrawal of the 35 U.S.C. §103 (a) rejection of claim 21 as being unpatentable over Bolgiano et al. in view of Koreltz et al.

Serial No. 10/821,595Docket No. 117-P-1345USD4

Double Patenting Rejection

Claims 20-27 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-27 and 41-51 of copending grandparent Application No. 09/560,170. Applicants would be willing to submit an appropriate Terminal Disclaimer should any of claims 20-27 in the present application and any of claims 20-27 and 41-51 in the grandparent application be allowed.

Conclusion

Hamrock et al.'s one-part radiation curable overcoat is not a two-part curable overcoat and does not anticipate claims 1-27, 36 or 37. Bolgiano et al.'s second layer is not a two-part curable overcoat, would be *more* strippable than Bolgiano et al.'s intermediate coating and does not anticipate claims 1-5, 7, 9-12, 15, 16, 18-24 or 27.

Koreltz et al.'s strippers are relatively mild, and would not be assumed by a person skilled in the art to be capable of removing Bolgiano et al.'s radiation-cured first layer. Even if Bolgiano et al. and Koreltz et al. were combined as proposed in the Office Action, the result would not make obvious a strippable laminate finish kit as recited in rejected claim 21, for at least the reason that Bolgiano et al. do not show a combination having a two-part curable overcoat that is "less strippable and more wear resistant than the dried intermediate coating".

The Double Patenting Rejection can be overcome via a Terminal Disclaimer when appropriate.

Withdrawal of the rejections and passage of the application to the issue branch are requested. The Examiner is encouraged to telephone the undersigned attorney at 612-331-7412 to discuss any unresolved questions regarding this application.

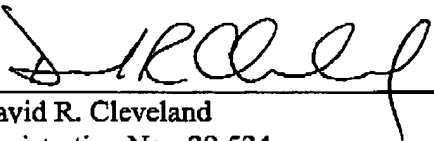
Serial No. 10/821,595

Docket No. 117-P-1345USD4

January 5, 2005

IPLM Group, P.A.
P.O. Box 18455
Minneapolis, MN 55418

Respectfully submitted on behalf of
Ecolab Inc.



David R. Cleveland
Registration No: 29,524
612-331-7412 (telephone)
612-331-7401 (facsimile)
USPTO Customer No. 23322